



Paper No. 6

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Tope-McKay & Associates
23852 Pacific Coast Highway #311
Malibu, CA 90265In re Application of
Ottusch, *et al.*
Application No. 09/882,817
Filed: June 15, 2001
Attorney Docket Number: HRL053

OFFICE OF PETITIONS

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the November 14, 2001 petition Under 37 C.F.R. §1.47(a).

HISTORY

Applicant filed the above-identified application on July 10, 2001, naming John Jacob Ottusch, Stephen M. Wandzura, Harry F. Contopanagos, John L. Visher, and Vladimir Rokhlin as joint inventors. However, the application as filed did not include the declaration executed as required by 37 C.F.R. §1.53.

Accordingly, on August 13, 2001, the Office of Initial Patent Examination mailed a notice to file missing parts (hereinafter "the notice") to the address of record. A two month extendable deadline was set for filing a reply.

Petitioner filed this reply on November 14, 2001, which under 37 C.F.R. §§1.6, 1.7, & 1.8, was timely.

LAW***§ 1.47 Filing when an inventor refuses to sign or cannot be reached.***

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(l) and the last known address of the nonsigning inventor. The Patent and Trademark Office shall, except in a continued prosecution application under §1.53(d), forward notice of the filing of the application to the nonsigning inventor at said address and publish notice of the filing of the application in the Official Gazette. The nonsigning inventor may subsequently join in the application on filing an oath or declaration complying with §1.63.

ANALYSIS

Petitioner correctly points out that among the requirements for a grantable petition is the requirement that the declaration be accompanied by the last known address of the nonsigning inventor.¹ No designation of the last known address has been made with this petition. The petition indicates that the address is entered in the declaration. However, no address is given for the nonsignor Contopanagos in the declaration. Petitioner is urged

¹ Petition under 37 C.F.R. §1.47, page 2, last paragraph.

to consider that for rule 47 purposes, the last known address is the one at which the non-signing inventor customarily receives mail.² Ordinarily, that address is the non-signing inventor's residential address.³

Petitioner has also failed to demonstrate that the nonsigning inventor has been provided with an opportunity to review the application and sign the required declaration. It is simply alleged that several contacts have been made with Mr. Contopanagos to secure his cooperation. No supporting evidence has been provided to corroborate these allegations. Petitioner is advised to consult the M.P.E.P. §409.03(d) for further information on what kind of showing is required to prove that the nonsigning inventor has refused to sign the declaration.

Because of the foregoing, this petition is *dismissed*.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.47(a)".

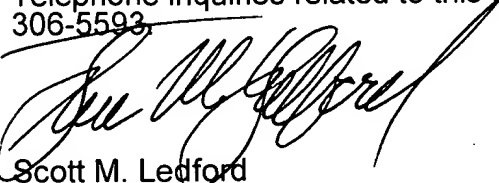
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703) 306-5593.



Scott M. Ledford
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Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

² M.P.E.P. §409.03(e)

³ *Id.*